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Cheol-Woong Lee

205,330

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EXAMINER

POPHAM, JEFFREY D

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/977,896

Applicant(s)

LEE ET AL.

Examiner

Jeffrey D. Popham

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

***Remarks***

Claims 1-17 are pending.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/29/2006 has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

It is also noted that, in the remarks filed 6/29/2006, applicant has equated a "kind" of music to be a genre of music (country, rock, etc.) and as such, the claims are rejected using such an interpretation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2137

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hale (U.S. Patent 6,732,180).

Regarding Claim 12,

Hale discloses a method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network, comprising:

Searching a network for an illegally produced digital music file, which is derived from a record of a cooperating record corporation (Column 6, lines 44-56; and Column 7, lines 24-67);

Identifying a plurality of digital music files that are substantially similar to the illegally produced digital music file (Column 7, line 24 to Column 8, line 37);

Collecting one of the plurality of digital music files that has a greatest number of files having the same name, size and playing time (Column 7, line 24 to Column 8, line 37);

Modifying the collected digital music file (Column 8, lines 1-37); and

Redistributing the modified digital music file through the network (Column 8, line 38 to Column 9, line 32).

Regarding Claim 14,

Hale discloses that the collecting and redistributing are performed by using a popular digital file sharing server (Column 10, line 42 to Column 11, line 26).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hale in view of Fanning (U.S. Patent 6,366,907).

Hale does not explicitly disclose that searching the network for the digital music file comprises searching the network according to a kind of music of the digital music file.

Fanning, however, discloses that searching the network for the digital music file comprises searching the network according to a kind of music of the digital music file (Column 3, lines 50-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the search engine of Fanning into the rights protection system of Hale in order to increase the search capabilities of the system, allowing it to find and protect more illegally distributed materials.

5. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale in view of Yoshiura (U.S. Patent 6,499,105).

Regarding Claim 15,

Hale does not explicitly disclose that modifying the digital music file comprises encrypting the collected digital music file with a predetermined key.

Yoshiura, however, discloses that modifying the collected digital music file comprises encrypting the collected digital music file with a predetermined key (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the rights protection system of Hale as modified by Fanning in order to allow the system to encrypt the data such that only a user with the correct private key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

Regarding Claim 16,

Hale as modified by Yoshiura discloses the method of claim 15, in addition, Yoshiura discloses that encrypting the collected digital music file comprises encrypting with a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Art Unit: 2137

6. Claims 1-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale in view of Fanning and Yoshiura.

Regarding Claim 1,

Hale discloses a method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network comprising:

a) collecting an illegally produced digital music file, which is derived from a record of a cooperating record corporation, by searching the network (Column 6, lines 44-56; and Column 7, lines 24-67);

b) modifying the collected digital music file (Column 8, lines 1-37);  
and

c) redistributing the modified digital music file through the network (Column 8, line 38 to Column 9, line 32);

But does not explicitly disclose that searching for the file is performed according to a kind of music of the digital music file or encrypting the digital music file with a predetermined key.

Fanning, however, discloses searching the network according to a kind of music of the digital music file (Column 3, lines 50-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the search engine of Fanning into the rights protection system of Hale in order to increase the search

capabilities of the system, allowing it to find and protect more illegally distributed materials.

Yoshiura, however, discloses encrypting the collected digital music file with a predetermined key (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the rights protection system of Hale as modified by Fanning in order to allow the system to encrypt the data such that only a user with the correct private key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

Regarding Claim 2,

Hale as modified by Fanning and Yoshiura discloses the method of claim 1, in addition, Hale discloses that at steps a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing program (Column 10, line 42 to Column 11, line 26).

Regarding Claim 3,

Hale as modified by Fanning and Yoshiura discloses the method of claim 1, in addition, Hale discloses that at steps a) and c) the collection and redistribution of the digital music file are performed by using a popular file sharing server (Column 10, line 42 to Column 11, line 26).



Regarding Claim 4,

Hale as modified by Fanning and Yoshiura discloses the method of claim 1, in addition, Yoshiura discloses that at step b) the collected digital music file is encrypted with a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 5,

Hale as modified by Fanning and Yoshiura discloses the method of claim 2, in addition, Yoshiura discloses that at step b) the collected digital music file is encrypted with a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 6,

Hale as modified by Fanning and Yoshiura discloses the method of claim 3, in addition, Yoshiura discloses that at step b) the collected digital music file is encrypted with a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 7,

Hale discloses a method of preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network comprising:

a) collecting an illegally produced digital music file, which is derived from a record of a cooperating record corporation by searching the network (Column 6, lines 44-56; and Column 7, lines 24-67);

b) modifying the collected digital music file (Column 8, lines 1-37);  
and

c) redistributing the modified digital music file through the network  
(Column 8, line 38 to Column 9, line 32);

But does not explicitly disclose that searching for the file is performed according to a kind of music of the digital music file or inserting a watermark containing a predetermined secret information in the digital music file.

Fanning, however, discloses searching the network according to a kind of music of the digital music file (Column 3, lines 50-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the search engine of Fanning into the rights protection system of Hale in order to increase the search capabilities of the system, allowing it to find and protect more illegally distributed materials.

Yoshiura, however, discloses inserting a watermark containing a predetermined secret information in the digital music file (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the rights protection system of Hale as modified by Fanning in order to allow the system to encrypt the data such that only a user with the correct private

key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

Regarding Claim 8,

Hale as modified by Fanning and Yoshiura discloses the method of claim 7, in addition, Hale discloses that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing program (Column 10, line 42 to Column 11, line 26).

Regarding Claim 9,

Hale as modified by Fanning and Yoshiura discloses the method of claim 7, in addition, Hale discloses that at step a) and c) the collection and redistribution of the digital music file are performed by using a popular digital file sharing server (Column 10, line 42 to Column 11, line 26).

Regarding Claim 10,

Hale as modified by Fanning and Yoshiura discloses the method of claim 1, in addition, Hale discloses that collecting the illegally produced digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time (Column 7, line 24 to Column 8, line 37).

Regarding Claim 11,

Hale as modified by Fanning and Yoshiura discloses the method of claim 7, in addition, Hale discloses that collecting the illegally produced

digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time (Column 7, line 24 to Column 8, line 37).

Regarding Claim 17,

Hale as modified by Fanning and Yoshiura discloses the method of claim 3, in addition, Yoshiura discloses that modifying the collected digital music file comprises inserting a watermark containing a predetermined secret information in the collected digital music file (Abstract; and Column 8, lines 34-67).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D Popham  
Examiner  
Art Unit 2137

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER